

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:	) Confirmation No.: 3885
Keiichi KUNIMOTO	)
Application No. 10/694,054	) Examiner: Troy Chambers
Filed: October 28, 2003	) Group Art Unit: 3641
For: TOY GUN	) Date: August 9, 2006

**PETITION PURSUANT TO 37 C.F.R. § 1.181, REQUESTING WITHDRAWAL OF  
THE FINALITY OF THE OFFICE ACTION DATED JULY 24, 2006**

**MAIL STOP PETITION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Petitioners request the Commissioner to invoke supervisory authority to instruct Examiner Chambers to withdraw the finality of the Office Action of August 8, 2003.

The relevant facts concerning this request are as follows:

1. The instant application was filed on October 28, 2003, with claims 1-6.
2. On May 17, 2005, Examiner Chambers issued a non-final Office Action in which claims 1-6 were rejected under 35 U.S.C. 102 based on U.S. Patent No. 6,138,656 to Rice et al. (hereinafter, "the Rice patent").
3. On August 17, 2005, the Petitioners filed an Amendment in which claims 1, 3, 5 and 6 were amended and claim 4 was canceled without prejudice or disclaimer.
4. On November 17, 2005, Examiner Chambers issued an Office Action in which the Rice et al. patent again was applied to reject pending claims 1-3, 5 and 6 under Section 102. This rejection was made final.
5. On January 18, 2006, an interview was conducted between the Petitioners' representatives and Examiner Chambers to discuss why the Petitioners believe the Rice et al. patent fails to describe all recited features of the finally rejected claims.
6. On February 15, 2006, the Petitioners filed a Request for Reconsideration, which traversed the November 17, 2005, final Office Action.

7. On April 5, 2006, the Examiner issued an Advisory Action in response to the Petitioners' arguments presented in the February 15, 2006, response.

8. On May 16, 2006, the Petitioners filed a Request for Continued Examination (RCE) and an Amendment in which the independent claim 1 and dependent claims 2 and 6 were amended.

9. On July 24, 2006, the Examiner issued a final Office Action. In the final Office Action, the Examiner withdrew the rejection based on the Rice patent, and in place of thereof, applied rejections with newly applied documents. Specifically, the final Office Action includes rejections under 35 U.S.C. § 102 based on U.S. Patent No. 5,476,087 to Kunimoto and U.S. Patent No. 5,477,843 to Kunimoto. Both of these rejections constitute new grounds of rejection.

9. On July 31, 2006, at about noon, the undersigned telephoned the Examiner and left a voice-mail message requesting that he withdraw the finality of the July 24, 2006, action because it includes a new grounds of rejection. The message also included an explanation of why the finality is premature.

10. On July 31, 2006, at about 9:00 PM, the Examiner left a message on the undersigned's voice mail informing that a response should be filed and to include a request to withdraw the finality of the Action.

11. The instant petition is submitted in response to the July 31, 2006 Office Action and the Examiner's comments in the July 31, 2006, voice mail message.

### **PETITIONER'S ARGUMENTS**

Since the mailing date of the final Office Action and Examiner's refusal to withdraw the finality of the July 24<sup>th</sup> Office Action occurred less than one month from the date of this Petition under 37 C.F.R. 1.181, the petition is considered timely. Additionally, MPEP § 706.07(b) instructs:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Furthermore, MPEP § 706.07(h)VIII states that the above conditions also apply to a submission filed along with an RCE. The present grounds of rejection, however, were never made of record prior to Petitioners' filing of the RCE and Amendment on May 16, 2006. Therefore, the finality is premature.

Furthermore, Petitioners take exception to the Examiner's instruction that a response to the final Office Action should be filed with arguments directed to why the finality is premature because it is not clear as to whether he would withdraw the finality to allow entry of any changes, if deemed necessary, in any such response to the pending rejections in which the Kunimoto patents are applied.

### CONCLUSION

For all of the above mentioned reasons, the Applicants submit that the finality of the July 24, 2006, Office Action is premature and its vacation believed warranted. Additionally, since the shortened statutory period for response to the Action continues to run, prompt attention to this matter would be greatly appreciated.

This petition is submitted under 37 C.F.R. 1.181 (no fee). However, should it be determined that a fee is due in order to complete this filing, the Commissioner is hereby authorized to charge any required fee, or credit any overpayment, to Deposit Account No. 19-2380 (740737-282).

Respectfully submitted,

/John F. Guay, Reg.# 47248/  
John F. Guay

NIXON PEABODY LLP  
Suite 900, 401 9<sup>th</sup> Street, N.W.  
Washington, D.C. 20004-2128  
(202) 585-8000